



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,317	07/09/2003	Thomas M. Sauter	KTWO121444	2817
26389	7590	06/02/2005	EXAMINER	
CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347			KLEBE, GERALD B	
			ART UNIT	PAPER NUMBER
			3618	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Interview Summary	Application No.	Applicant(s)	
	10/617,317	SAUTER ET AL.	
	Examiner	Art Unit	
	Gerald B. Klebe	3618	

All participants (applicant, applicant's representative, PTO personnel):

(1) Gerald B. Klebe/Examiner/AU3618. (3) _____.

(2) Ryan Dodge, Jr/RegNo42492/Att'y for Applicant. (4) _____.

Date of Interview: 26 May 2005.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____.

Claim(s) discussed: independent claims 15, 25 and 26.

Identification of prior art discussed: Swearington (US 5056509).

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: see continuation sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

G B Klebe 26 May 2005
Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation Sheet (PTOL-413) Continuation of Substance of Interview, including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Attorney Ryan Dodge called to address a number of issues he had with the final rejections made against the claims in the Office action mailed 03/22/2005. Attorney Dodge took issue with the examiner's final rejections of the claim under 35 USC 103(a) based on the combination of Gierveld (US 5046746) in view of Swearington (US 5056509) (hereinafter "Swearington"). The Attorney took issue specifically relative to rejections in the area of three recited limitations of the independent claims: (1) the recited limitation of the claims that the heel counter is fixedly secured to the base [of the skate]; the Attorney being of the opinion that this recited feature of the claims was overlooked by the examiner in his Office action rejections; (2) the examiner's reliance on/attribution of rigidity in the ankle support of Swearington given the reference text at column 2, lines 47-49 of the reference wherein it is stated that the ankle brace is formed of flexible plastic material; and (3) the examiner's interpretation of the claim(s) recitations that the ankle support cuff is constrained to pivot about (as recited in claims 15 and 25) an axis transverse to the longitudinal axis defined by the base, or (as recited in claim 26) wherein the cuff pivots only about such an axis.

Regarding issue (1) the examiner pointed out that the recitation wherein the heel counter is fixedly secured to the base is addressed in the Office action at page 5, subparagraph e. The Attorney took notice that this limitation is addressed in the action.

Regarding issue (2), the examiner reiterated his argument-in-response as found in the Office action at page 11, paragraph 9, subparagraph b.(i) that admittedly, the reference stating that the ankle brace is "formed of flexible plastic", for the examiner to take the position that the ankle brace is also "substantially rigid", requires some interpretation of the reference. The examiner's position being, as stated in the Office action, that to provide the ankle with the support of a brace, the brace must have substantial rigidity and that a possible resolution of the apparent inconsistency is that reference, in stating that the brace is flexible plastic is implying that the plastic has some softness to provide cushion where it engages the user's ankle. The examiner continues to hold that the structure of the reference, being a brace for use in a sport shoe inherently must be substantially rigid at least insofar as needed to provide sufficient bracing forces in support of the user's ankle. The examiner posits that the statement of the reference that the brace is flexible plastic cannot reasonably be interpreted to mean that the plastic is devoid of rigidity.

Finally regarding issue (3), the Attorney and examiner addressed the rejection in view of the Figure 5 of the reference. The examiner here, also, reiterated his position stated in the Office action. While acknowledging that the ankle support of Swearington provides for pivoting of the ankle support cuff about both a longitudinal axis and a transverse axis as shown in the Figure 5, the examiner restated that the rejections as found in the Office action of each of these claim recitations relies on the well-settled finding of law that it is within the skill of a worker in the art to omit an element and the function provided thereby if that element or that function is desired or required. The examiner further suggesting that since the intended use of the ankle brace of Swearington is in a sport shoe, rather than a medical application, it would have been obvious to a worker in the art to omit either one or both of the pivots depending upon their perceived lack of usefulness in the sport where the combination skate and ankle brace was anticipated to be used.

During the interview, there was substantial collegial back and forth discussion of each of these issues between the Attorney and the examiner, indeed with each issue being addressed more than once during the interview, but concluding with no resolution on any of these. *ABK 26 May 2005*